UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,790	08/27/2003	Clark Easter	026063-00014	4489

4372   7590   05/21/2009
ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

NOTIFICATION DATE	DELIVERY MODE
05/21/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2009*.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,14-33 and 47- 48* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-11,14-33 and 47- 48* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the amendment filed 03/30/2009.

Claims 1-11, 14-33, and 47-48 are currently pending. Claims 1, 21, 22, and 33

have been amended. Claims 1, 21, 22, and 33 are independent Claims.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition
of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.*

Claim 33 remains rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Regarding independent Claim 33, the Examiner notes that a computer usable

medium having control logic is directed to statutory subject matter so long as the

language of the claim is not supported in the Specification with non-statutory

embodiments (i.e., signals, transmission mediums and the like). See In re Nuijten,

500 F.3d 1346, 1357 (Fed. Cir. 2007) (A claim directed to computer instructions

embodied in a signal is not statutory under 35 U.S.C. § 101).

In the present case, Applicant's Specification discloses that the computer usable

medium (that includes signal bearing media) is intended to broadly encompass "a

propagated signal on a carrier" (Specification, page 20, lines 4-11). Because

Applicant's claims broadly read on signals and other non tangible transmission

mediums, the Examiner concludes that independent Claim 33 is directed to non-

statutory subject matter.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11, 14- 33, and 47-48 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Roper** (US 6270351) in view of **Morley et al.** (US 2004/0148192)

and further in view of **Bates et al.** (US 7398467).

As to claim 1:

Roper teaches a computer-implemented method for providing interactive

assistance with populating an automated document that includes at least one field,

the computer comprising a processor, a data repository, and a user interface *(see*

Abstract & col. 2, lines 1-35; SEE ALSO, Figs. 1-5), the method comprising:

- selecting, via the processor, an entity to which the document applies (S*ee*

  Col.2, lines 1-44 and Col.4, lines 32-44);

- assigning , via the processor, a prioritization to each of the at least one field,

  the prioritization stored in the data repository *(e.g., when a user logs onto*

  the individual education program system, he must enter a login ID and

  password...Once the records are saved, the individual education program

  tracking system returs control to the main menu 400; See Col. 8, lines 15-29;

  see also, Figs.5-8);

- prompting, via the processor, for a response for each of the at least one field

  (e.g., Once the student profile is generated ... prompting the user of the

  system for certain basic information regarding the regarding the student ...

  includes the student's name, age, birthdate, grade; See Col. 6, lines 10-18 &

see fig. 7), the prompting varying based on the prioritization of each of the

at least one field *(See Col.6, lines 1-21; see also, Figs.5-8)*;

- iteratively, via the processor, revising the prioritization of all of the at least one

  field upon receiving the response to each of the at least one field *(e.g., the*

  system automatically brings up the student's current IEP record ... The next

  step in the process for editing an existing individual education plan comprises

  displaying the student's information screen for the current individual education

  plan on the computer monitor ... Changes in the student information may be

  made on this screen by the users of the system) [See the discussion beginning at

  col.7, line 30]; and

- prompting, via the processor, for a response for at least one field, the

  prompting varying based on the iteratively revised prioritization of all of the at

  least one field *(e.g., before an individual education plan may be created, a*

  student profile is created by entering information about the student. The user of

  the system selects the Enter/Edit Student information option 402 from the main

  menu 400. Selecting this option brings up a student information screen. Via the

  student information screen, the user of the system may enter all pertinent

  information relating to the particular student... records are saved, the

  individual education program tracking system returns control to the main

  menu 400 ... Typically, a state has requirements that must be met before a

  student can enter a special education plan, such as that provided by an

individual education plan. These requirements include an assessment of a

student's skills and parental (guardian) authorization. The individual

education program tracking system automatically generates the forms for

complying with these regulatory requirements. Once the requirements have

been met, then an individual education plan may be created for a student) [See

the discussion beginning at Col.8, line 15]; and

- displaying, via the user, the populated document [See Col. 8, line 44 - Col.

  9, line 27 → *generating forms from which the user of the system may*

  select ... Selection of the Initial Referral option 602 results in bringing up

  a screen for the generation of an Initial Referral Form. This form is

  typically completed by the student's regular education teacher. The form is

  utilized to make a request that a student be evaluated for Special

  Education and lists the reasons upon which the request is being made].

Roper, however, does not specifically teach "*performing, via the processor, a*

compliance check for each response for the at least one field to determine if the

response complies with predetermined legal requirements."

Morley teaches performing a compliance check for each response for the at least one

field to determine if the response complies with predetermined legal requirements

(*See the Abstract and [0015] – [0018]* → *perform a compliance rules analysis on*

the data of the existing Form I-9 document to determine whether the existing Form I-

9 document was correctly completed ... complete the Form I-9's associated with a

particular employer as identified by performing the compliance rules analysis on the

Form I-9 documents associated with a particular employer ... identify both blank

fields and inconsistent entries, such as the selection of incompatible document types

or the entry of incompatible dates, which cannot be correct).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify Roper with Morley because it would have managed

all of the employment eligibility forms associated with particular employers, to

assure continued compliance with federal regulations.

The combination of Roper and Morley does not specifically teach "varying, via the

processor, a color of each of the at least one field based on the prioritization."

Bates teaches varying a color of each of the at least one field based on the

prioritization *[See fig. 3 and col. 3, lines 18-43: Each record is associated with a*

respective WORD field 310, a respective PRIORITY field 320, a respective COLOR

field 330 ... The PRIORITY field 320 indicates a priority level ... determine which

problem word should receive high priority].

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine Bates with Roper as modified by Morley because it

would have indicated a priority level for each field in the form and facilitated

correction of the fields.

As to claim 2:

Roper teaches the document is a form *(e.g., form; col.5, lines 20-25)*.

As to claim 3:

Roper teaches the form is used for compliance with educational requirements

(e.g., forms required by either or both local school districts and state departments

of education; Col.2, lines 26-30).

As to claim 4:

Roper teaches the educational requirements include requirements under the

Individuals with Disabilities Education Act *(see col.1, lines 16-34)*.

As to claim 5:

Roper teaches identifying data from an accessible repository responsive to any of

the at least one field of the document *(see item StudentID in fig.5)*; and

automatically populating each of the at least one field of the document for which

the responsive data from the accessible repository are identified *(col.9, lines 1-46*

and see fig.9).

As to claim 6:

Refer to the discussion of claim 4 above for rejection.

As to claim 7:

Roper teaches teach if the compliance check passes, providing an option to lock

the document *(See Col. 13, lines 1-13 and Fig. 1)*.

As to claim 8:

Roper teaches receiving a selection of a response to the option to lock the

document; and if the selection is to lock the document, preventing revision of each

of the responses to the at least one field *(e.g., If the user selects the Lock This IEP*

option 1710, the system locks the individual education plan record in the individual

education program database 18 from any further modifications; See Col.13, lines 1-

13 and see Fig.1).

As to claim 9:

Roper teaches prompting a user for security information *(e.g., enter a login ID*

and password; See Col.7, lines 15-16).

As to claim 10:

Roper teaches the entity is an individual *(e.g., an individual; See the Abstract)*.

As to claim 11:

Roper teaches storing the automated document with the response to each of the at

least one field *(See Figs. 9-11 and associated text)*.

As to claim 14:

Roper teaches identifying data from an accessible repository responsive to any of

the at least one field of the document *(see item StudentID in fig.5)*; and

automatically populating each of the at least one field of the document for which

the responsive data from the accessible repository are identified *(See Col.9, lines*

1-46 and See Fig.9); and highlighting each of the at least one field containing

automatic populating *(See Figs. 7-8)*.

As to claim 15:

Roper teaches prompting for a response to one field is selected from, among other

things, prompting for an optional response *(e.g., selection of the Enter/Edit*

Student Information of the main menu; See Col.6, lines 1-42 & Col.7, line 60-

Col.8, line 14).

As to claim 16:

Roper teaches selecting an entity to which the document applies includes

searching a repository containing at least one entity *(See Col.6, lines 22-58 and*

See Fig.1).

As to claim 17:

Roper teaches providing an option to select the automated document form a

plurality of documents *(See Col.6, lines 1-42 & Col.7, line 60- col.8, line 14)*.

As to claim 18:

Roper teaches generating the plurality of documents via a search *(See Col.5, line*

59- Col.6, line 58).

As to claim 19:

Roper teaches the automated document is associated with a meeting *(See Col.9,*

line 47- Col.10, line 7 and See Fig.12).

As to claim 20:

Roper teaches the meeting includes at least one event *(See col.9, line 47-col.10,*

line 7 and see Fig.12).

As to claim 21:

Refer to the discussion of Claim 1 above for rejection. Claim 21 is the same as

Claim 1, except Claim 21 is a system Claim and Claim 1 is a method Claim.

As to claim 22:

The rejection of claim 21 above is incorporated herein in full. Additionally, Roper

teaches a processor *(e.g., computers)*; a user interface *(e.g., a user-friendly*

interface; *col.4, line 20)*; and a repository *(e.g., a central database) [See Col.2,*

lines 54-63 and col.4, lines 1-53).

As to claim 23:

Roper teaches the processor is housed on a terminal *(e.g., a personal computer;*

See Col.4, lines 4-5).

As to claim 24:

Roper teaches the terminal is selected from, among other things, a personal

computer *(e.g., a personal computer; See Col.4, lines 4-5)*.

As to claim 25:

Roper teaches the processor is housed on a server *(e.g., the server 10; See Col.4,*

line 3 and see Fig.1).

As to claim 26:

Roper teaches the server is selected from, among other things, a personal

computer *(e.g., a personal computer; See Col.4, lines 4-5).*

As to claim 27:

Roper teaches the server is coupled to a network *(e.g., the network; SeeCol.4,*

lines 5-16 and See Fig.1).

As to claim 28:

The use of the Internet is inherent to the system of Roper.

As to claim 29:

Roper teaches the server is coupled to the network via a coupling *(See Col.4, lines*

3-16).

As to claim 30:

Roper teaches the coupling is selected from a group consisting of a wired

connection, a wireless connection, and a fiberoptic connection (*e.g., See Fig.1 and*

the accompanying text beginning at Col.3, line 63).

As to claim 31:

Roper teaches the repository is housed on a server *(e.g., the server 10; See Col.4,*

line 3 and see Fig.1).

As to claim 32:

Refer to the discussion of Claim 27 above for rejection.

<u>As to claim 33:</u>

Note the rejection of claim 1 above. Claim 33 is the same as claim 1, except

Claim 33 is a computer program product Claim and Claim 1 is a method Claim.

As to claims 47-48:

Refer to the discussion of Claim 4 above for rejections.

Response to Arguments

4.   Applicant's arguments filed 03/30/2009 have been fully considered but they are not

persuasive.

        a.   **<u>Regarding the 35 USC § 101 rejection</u>**

                Applicant argues in substance that Claim 33 does not recite a "signal" ... it is

                important not to import into a claim limitations that are not part of the claim.

                [Remarks, page 12].

In response, Claim 33 recites a "computer usable medium" and the computer

usable medium is broadly read on signals and other non tangible transmission

mediums (Specification, page 20, lines 4-11), Claim 33 is directed to non-

statutory subject matter. The meaning of every term used in any of the claims

should be apparent from the descriptive portion of the specification with clear

disclosure as to its import (see MPEP § 608.01(o)). The claim or claims must

conform to the invention as set forth in the remainder of the specification and the

terms and phrases used in the claims must find clear support or antecedent basis

in the description so that the meaning of the terms in the claims may be

ascertainable by reference to the description (see CFR 1.75(d)(1)).

b.   Regarding the 35 USC § 103 rejection

With respect to independent claims 1, 21, 22, and 33, Applicant simply points

out what are recited in the claims and asserts that "[C]ombining Roper with

Morley and Bates would teach away from the principle of operation of Roper

and therefore, the combination of these references is improper" [Remarks,

pages 13-15]. This quote is the extent of explanation provided by Applicant

in support of Claims 1, 21, 22, and 33. This response by Applicant is

insufficient to satisfy the requirement of specific argument to have the claims

considered for patentability; in accordance with 37 C.F.R. § 1.111 Applicant

must distinctly and specifically point out "how the language of the claims

patentably distinguishes them from the references". In the Office Action, the

examiner mapped each claimed limitation to specific element(s) and/or

relevant passages in the Roper, Morley and Bates references to show how the

references meet the cited claim limitations. Applicant in response did not

provide any underlying analysis as to why the portions of the prior art relied

on did not support the examiner's position. Accordingly, a prima facie case of

obviousness is maintained as set forth in the rejections above.

Applicant argues in substance that the Office Action fails to provide a reason

to combine the cited references [Remarks, page 12].

In response, Examiner notes that the test for the relevance of a cited

combination of references is: "whether the teachings of the prior art, taken as

a whole, would have made obvious the claimed invention," *In re Gorman*, 933

F.2d at 986, 18 USPQ2d at 1888. Subject matter is unpatentable under section

103 if it would have been obvious ... to a person having ordinary skill in the

art. While there must be some teaching, reason, suggestion, or motivation to

combine existing elements to produce the claimed device, it is not necessary

that the cited references or prior art specifically suggest making the

combination: *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502

(Fed. Cir. 1988)." Such suggestion or motivation to combine prior art

teachings can derive solely from the existence of a teaching, which one of

ordinary skill in the art would be presumed to know, and the use of that

teaching to solve the same [or] similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). "In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

Conclusion

5.   The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the

advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will

be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the

mailing date of this final action.

Contact information

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Maikhanh Nguyen whose telephone number is

(571) 272-4093. The examiner can normally be reached on Monday - Friday from

9:00am – 5:30 pm. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571)

272-4137.

The fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or

access to the automated information system, call 800-786-9199 (IN USA OR

CANADA) or 571-272-1000.

/Maikhanh Nguyen/
Examiner, Art Unit 2176

/Laurie Ries/
Primary Examiner
Technology Center 2100
18 May 2009